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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/735,697 12/12/00 LEE

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LARIVIERE, GRUBMAN & PAYNE, LLP
1 LOWER RAGSDALE, BLDG. 1, SUITE 130
P.O. BOX 3140
MONTEREY CA 93942

EXAMINER

POLK, S

ART UNIT

PAPER NUMBER

2836

DATE MAILED:

11/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/735,697

Applicant(s)

LEE, NOEL

Examiner

Sharon Polk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. The Examiner has reopened prosecution. As such, Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.
2. The examiner traverses applicant's assertion that "the examiner concludes that Exhibit A of the foregoing Declaration (herewith submitted) is not the claimed invention in order to summarily dismissed the antedating issue." The declaration of Noel Lee has been considered as evidence of conception to antedate the September 1997. However, it is well settled as to what "conception" means in terms of the claimed invention.

Kridl v. McCormick, 105 F.3d 1446, 1449, 41 USPQ2d 1686, 1689 (Fed. Cir. 1997) ("Conception is the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is therefore to be applied in practice." ... Conception must include every feature or limitation of the claimed invention."); Coleman v. Dines, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985) ("in establishing conception a party must show possession of every feature recited in the count, and ... every limitation of the count must have been known to the inventor at the time of the alleged conception."); Hunter v. Beissbarth, 230 USPQ 365, 367 (Bd. Pat. App. & Int'f 1986) ("A party claiming conception must show possession of every feature recited in the counts and every limitation of the counts must be shown to have been known to the inventor at the time the invention is alleged to have been conceived; the requirement for corroboration of an inventor's testimony is well-established."); Salem v. Bendell, 217 USPQ 920, 924 (Bd. Pat. Int'f 1982) ("A party claiming conception must show possession of every feature recited in the counts and every limitation of the counts must be shown to have been known to the inventor at the time the invention is alleged to have been conceived. ...").

As such, the examiner did not summarily dismiss the antedating issue, rather, the applicant failed to show how **each and every element** was clearly delineated in the either the declaration submitted by Noel Lee and the informal law drawing dated July 28, 1994. Applicant is reminded that it is not the examiner's job to decipher what the conceived invention was based on a drawing showing a *general viable prototype*. It is

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the examiner's job to evaluate all the submitted evidence and determine what the applicant has proven. Here the applicant has not proved that the claimed invention was conceived prior to September 1997. Therefore, the declaration submitted by Mr. Lee and the proprietary drawing are not persuasive.

3. In regards to applicant's evidence of common ownership, applicant is reminded that matters of obligation of assignment are not issues with which the Patent Office considers when determining patentability. Applicant is invited to respond as to why it is felt that the office is obligated to consider it.

4. In regards to applicant's Declarations submitted as evidence of secondary considerations; the examiner has stated that they have been reconsidered. While they may be persuasive regarding commercial success and long felt need. They are not enough in and of themselves to dismiss prior art which teach or fairly suggest the claimed invention prior to Monster cables admitted first commercially viable prototype manufactured in September 1997.

5. In response to applicant's inaccurate statements regarding telephonic interview May 11, 2000. The examiner graciously granted a telephonic interview, within one day of applicant's request. Below is the interview summary of the telephonic interview. The applicant's assertion that the examiner stated "I just don't see anything inventive here," is inaccurate.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Attorney discussed claims 1-3, 5-6 and indicated that they were broad and may be cancelled, independent claim 8 was distinguished from the other independent claims by being a power strip arrangement from the factory, independent claim 14 was distinguished from the other independent claims as being an

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after market or retrofit kit. Attorney mentioned the possibility of combining independent claim 20 with claim 21, and also combining independent claim 23 with claim 24. Attorney stressed that the inventor Noel Lee says that this invention is different from his cited patent U.S. 5,589,718, and intimated the thought differences. The discussion went back and forth about the combination of references with Mr. Flores and Ms. Dettaan feeling that the references did not teach the claimed invention, and the Examiner strongly feeling and articulating that the combination of the references clearly suggests the claimed invention. Attorney expressed that the "plurality of stickers" are what distinguishes the invention over the prior art. No formal or informal agreement was reached. Examiner agreed to review the proposed amendments and arguments. Attorney requested that the proposed amendments be informal. However examiner said that she would respond within 24 hours to let them know if the submission should be formal or informal.

6. In response to applicant's assertions regarding improper 35 U.S.C. § 103, some of the references examiner used solves the same problem as the applicant is intending to solve: fast visual identification of end to end connections. A reference that is directed to another art but teaches, or fairly suggest the claimed invention is a proper rejection under § 103. Certainly all of the reference selected are within the electrical/wiring/power connection art.

7. In response to applicant's submission that the examiner "under the guise of 'Official Privilege'" is disparaging applicant's invention. The examiner will attempt for the third time to impart upon the applicant that she is not diminishing or discounting the invention. She is merely indicating that the invention was taught or fairly suggested in prior art. Phrases such as "person[s] with less than that of ordinary ^ksill in the art" and "person's with no skill in the art" are not meant to inflame the applicant. But attempts to impart that color coding in and of it self is notorious. The examiner directs applicant to the English translation of the abstract of JP 408265937A, which states "These switches, connectors and receptacles are differentiated in color and shape for different uses.

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Electric apparatus are previously built in, adjusted and tested at a furniture factory.

Consequently, the schedule of electric wiring work is shortened in the building work and the wiring work can be carried out by a small number of unskilled workers. (Emphasis added). Essentially, "unskilled," (less than that of ordinary skill, and no skill) people understand color coding and implicitly in the method of color coding is keeping (matching) like colors.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 29, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over article entitled Smarter Strip, U.S. News & World Report, May 5, 1997, written by Leonard Wiener.

This article discloses the claimed invention except for peripheral devices. However, it is understood that power strips having outlets, and power cords will be associated with peripheral devices. It is noted that this article discloses that "The outlets are color coded, with colored labels supplied, to identify power cords quickly;" This reference discloses a motivation, (the same as the applicant's) as to why it would have been obvious to one of ordinary skill in the art to modify existing power strips, i.e. to identify power cords quickly.

10. Claims 29-36, and 38, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,589,718 ('718 Pat.).

11. The '718 Pat. teaches an input power cord (14), a plurality of output receptacles (16a-h), and a housing member (12). This reference does not specifically disclose an insulated housing. However, insulation is an inherent property of any electrical device because it serves as protection means. Additionally, the '718 Pat. teaches color-coding system such that the outlets are assigned a different color. (3:35-51, and 4:1-7).

Claim 33– The '718 Pat. teaches an AC, electrical power strip apparatus (10) having a plurality of outlets (16a-16h) comprising an input power cord member (14), an electrical distribution main electrically coupled to said input power cord member and to said plurality of electrical outlets (col. 1, lines 66-67, and col. 2, lines 1-3). '718 Pat. teaches a housing member (12) for housing said distribution mains and said outlets, and for securing said power cord member to said main, said housing have a plurality of discrete areas for receiving a plurality of colored stickers and a plurality of color coded for retrofitting said plurality of outlets, said plurality of colored stickers and said plurality of color coded indicia provided for associating certain ones of said plurality of outlets with a particular color, and for associating certain ones of said plurality of outlets with said plurality of peripheral devices.

The '718 Pat. does not expressly disclose stickers, however, '718 Pat. discloses:

[T]he cables that interconnect the above components could have a **red designation** (whether it be by coloring the cables red or **applying a red indicia**, such as stripes or rings on the cables or on the connectors attached to the cables).

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('718 Pat., at 3:50-51, and 4:1-3). (emphasis added).

The '718 Pat. does not expressly claim or disclose a "plurality of colored stickers." However, well within the scope of the invention is a plurality of color stickers.

[E]ach outlet 16a-16h, and the corresponding portion of the housing containing same would be **color-coded** to correspond to the particular component to be powered thereby. In fact, **a color coding scheme** could be imparted to the entire audio-video system including the interconnects that connect the various components.

('718 Pat., at 3:37-43). (emphasis added).

'718 Pat. does not expressly disclose that a sticker is to be attached to a peripheral device. However, it can be inferred by use of the phrase entire audio-video system. (*Id.*, at 42). Examiner interprets entire as follows: Entire is defined as having no element or part left out. (Webster's, at 387). Therefore it would be reasonable to infer that the peripheral device would be included as *part* of the entire audio-video system. Alternatively, '718 Pat. discloses:

For example, audio program **sources**, such as CD players, Record players, tape decks and AM/FM tuners would be **assigned a certain color**, such as red[.] (at 3:43-45). (emphasis added).

It is also obvious to infer that a source would not only be assigned a color, but would have indicia indicating that the source was assigned a certain color.

Claim 34 – The '718 Pat., discloses all things previously discussed but also teaches the following limitations: a plurality of sets of a plurality of colored stickers for selective attachment to an interconnecting electrical cord, each colored sticker being distinct, and colored a different color than other color sticker provided on the said portions,

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According to another feature of the present invention, an input **designating indicia** is associated with each outlet 16a-16h to **clearly identify** the type of component that should be used with each outlet in accordance with the type of **AC power** processing associated with the **outlet**.

(*Id.*, at 3:33-37). (emphasis added).

The '718 Pat. does not expressly recite that the colored stickers are distinct from other colored stickers in the set. However '718 Pat., at 4:3-7 discloses;

The video source components, and the outlets 16e and 16f, would be assigned another color and the audio amplifiers, and the outlets 16g and 16h would be assigned still another color.

Therefore, it is clear that they are distinct.

Claim 35 – depends from claim 33, and adds the limitation of colored electrical extension cords, along with the matching color code scheme as previously recited.

The '718 Pat. teaches;

[T]he **cables** that interconnect the above components could have a red designation (**whether it be by coloring the cables red** or applying a red indicia, such as stripes or rings on the cables or on the **connectors attached to the cables**).

('718 Pat., at 3:50-51, and 4:1-3). (emphasis added).

Examiner notes that "Cables that interconnect the above components" (*Id.*) is a sufficient description of an extension cord. Further, a plurality of extension cords is consistent with the scope of the invention of '718 Pat., because it is understood that each assigned color portion may need a matching cable that interconnects the above components. As such '718 Pat. teaches this limitation.

Claim 36 – depends from claim 35, and does not add any new limitations not discussed in previous claims.

Claim 38 – is a method claim with follows the apparatus. As such all applicable art rejections based on the apparatus, correspond to this method claim 38.

Claim 40 – depends form claim 39, and adds the limitations regarding the plurality of extension cords. See above for discussion.

It would have been obvious to one of ordinary skill in the art to modify the device taught by '718 Pat., to include stickers to attach to either: discrete areas of the housing extension cords, or peripheral devices or any combination/sub-combination thereof, because consistent with the scope of the '718 Pat. invention, color indicia /(stickers) attached throughout the entire system (powerstrip, extension cord, peripheral device) *enables the various outlets provided to be **easily identified** and thus insures that each component connected thereto will be connected to an outlet specifically designed for the particular electronic characteristic for the component.* ('718 Pat., at 4:14-18). (emphasis added).

12. Claims 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5, 589,718 ('718 Pat.) in view of article entitled Smarter Strip, U.S. News & World Report, May 5, 1997, written by Leonard Wiener.

The '718 Pat. does not disclose a kit. However, Smarter Strip discloses that labels are supplied. And because the claimed kit *only* contains stickers, it is well within the teachings of Smarter Strip. As such it would have been obvious to one of ordinary skill in the art to modify '718 Pat. to include a kit of labels because the '718 Pat.

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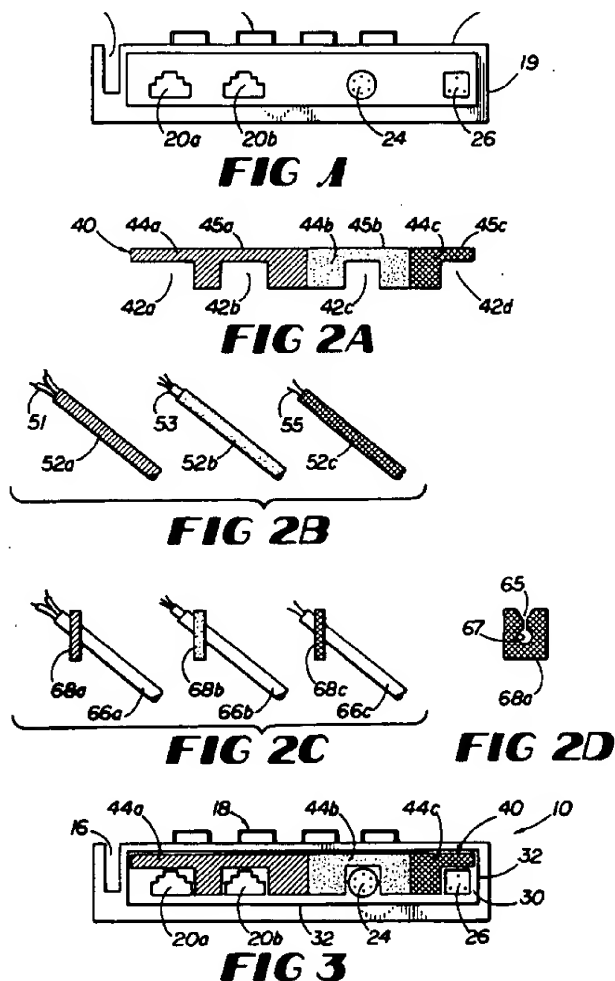
teaches that interconnect the above components could have a red designation (whether it be by coloring the cables red or applying a red indicia. Clearly this can imply an aftermarket remedy to solve the problem of properly identifying each components associated with each outlet, with Smarter Strip teaching labels being supplied to identify power cords quickly.

13. Claims 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5, 589,718 ('718 Pat.) and U.S. Patent 5,775,935, Barna, further in view of U.S. Patent 5,366,250, Sunabe.

The '718 Pat, does not expressly teach stickers or stickers having indicia on them. However, Barna teaches a color coded alignment strip (40), (see figures below) attached to a device, which corresponds to color coded cables (52a, 52b, and 52c). The color coded alignment strip (which extends entirely around the electrical connection ports) is positioned and aligned in a recessed area (30) such that the colors of the alignment strip match the color of the cables.

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Barna explicitly teaches the color of the power cord connection cable (52c) corresponds with the color (44c) of a section of the color coded alignment strip. (5:16-19). Barna also teaches color-coding with tags (68a). Official notice is taken that the



sticker and tag solve the same problem of properly identifying proper connection via a color code system. Hence, both function to ensure easy visual indication.

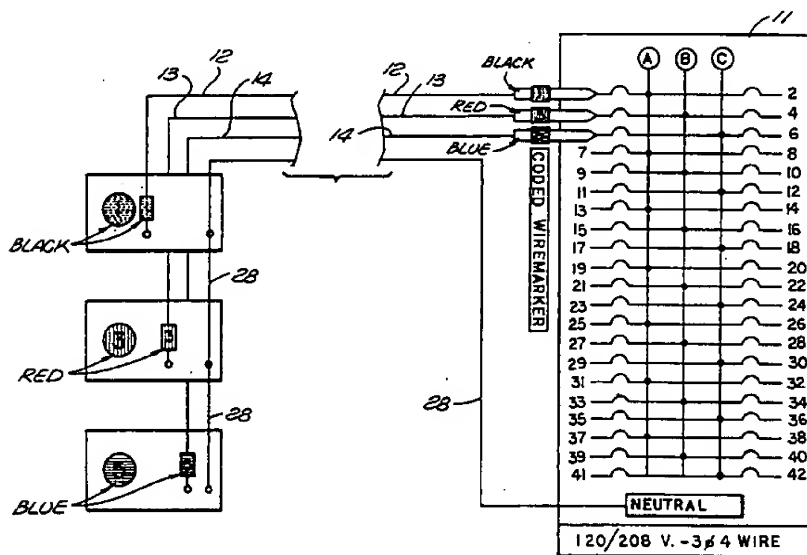
It is obvious to one of ordinary skill in the art at the time of the invention to modify '718 Pat. with the teachings of Barna, because Barna objective was to "provide a cable

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connecting system that secure a color coded alignment strip [] in a manner that prevents inadvertent removal of the alignment strip." (Barna, at 3:19-22).

Sunabe teaches a set of wire markers (22), a set of outlet box markers (23) with the markers carried on the carrier with each marker of each set being separable peelable from the carrier. (at 3:50-53). The markers are numbered sequentially and are color coded red, black, and blue. See figure above.

It would have been obvious to one of ordinary skill in the art to modify the teachings of "718 Pat., and Barna, with the teachings of Sunabe because as Sunabe discloses a visual pattern system reduces errors in wiring, and also makes tracing



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easier, and provides codes with stand out from conventional wiring diagrams, by "providing two indicia in a single component." (at 3:25-26).

14. Claims 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over article entitled Smarter Strip, U.S. News & World Report, May 5, 1997, written by Leonard Wiener, in view of U.S. Patent No. 5,366,250, Sunabe.

Smarter strip teaches an electrical power strip apparatus, comprising a input power cord, an electrical distribution main, a plurality of electrical output receptacles, a housing members to accommodate AC adapters. The outlets are color coded, with colored labels supplied, to identify power cords quickly. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Smarter strip with the teachings of Sunabe because both solve the same problem utilizing indicia/indicia means for "end to end" correct attachment of cords to reduce errors or mistakes in connecting or disconnecting of cords.

Conclusion

15. No claims are allowed.

16. The prior art made of record and not relied upon at this time is considered pertinent to applicant's disclosure: Article, entitled "'Designer' Surge Protectors Debut from Kensington", which disclose color-coded sockets and matching identification rings to be placed on the electrical device that is to be plugged into it, U.S. Patent No. Des. 401,221, which discloses a color coded electrical outlet, U.S. Patent No. Des. 401,220, which discloses a color coded power strip, U.S. Patent No. 5,900,804 which discloses a

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power cord system, U.S. Patent No. 5,051,870, which discloses an electronic socket attachment method and identification system, U.S. Patent No. 4,752,245, which discloses a plug and receptacle apparatus color coded to give ready visual indication, English abstract of JP 409146463A which discloses a name tag for a power cord, JP 409146463A, English abstract of JP 408265937A, which discloses a unit wiring connection structure for floor box using color coded wiring.

16. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Communications With The PTO

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Polk whose telephone number is 703-308-6257. The examiner can normally be reached on M-F 7-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Josie Ballato can be reached on 703-308-0269. The fax numbers for the organization where this application or proceeding is assigned are 703-308-3914 for regular communications and 703-308-3914 for After Final communications.

October 26, 2001

Sharon Polk

Patent Examiner

Art Unit 2836


Josie Ballato
Supervisory Patent Examiner
Technology Center 2800
10/30/01